

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-3, 5-9 and 11 are presently pending. Claim 10 was withdrawn previously from consideration without prejudice pursuant to a restriction requirement. Claim 4 has been cancelled herewith. Claims 1, 3, 5-9 and 11 have been amended herewith. No new matter has been added. Support for the amendments is found throughout the Specification and the associated drawings.

In the Office Action, it was asserted as follow: (1) Claims 1-9 were rejected under 35 U.S.C. § 101 for being directed to nonstatutory subject matter; (2) Claims 1-7 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness; and (3) Claims 1-9 and 11 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of U.S. Patent No. 5,629,980 (“Stefik”) and U.S. Patent No. 5,563,946 (“Cooper”), and further in view of U.S. Patent No. 6,009,401 (“Horstmann”). Applicants respectfully traverse these objections.

By way of background and not by limitation, the inventions claimed in the present application are directed to content delivery systems for the delivery of the content of licensed, copyrighted works from content providers to users who have systems containing multiple apparatuses that are capable of receiving and using such works. The systems of the present invention make it possible for a single user who has multiple clients in one system to readily share the contents of a copyrighted work between that user’s clients while still protecting the copyright in the contents of the work. The system of the present invention overcomes problems associated with single-license systems, in which the terms of a single license are typically set when the work is first created and/or first distributed. Because the terms of such single-license systems are previously set, single-license systems may not allow a user who has multiple client apparatuses to readily transfer a copyrighted work from one client to

another client of the same user, or they may do so pursuant to terms which are pre-determined by the copyright owner and which are attached to the work itself, and thus, those rights are fixed and inflexible. These and other drawbacks of single-licensing system for distributing content between multiple client apparatuses of a single user may be overcome by the present invention.

A. The § 101 Rejection

In the Office Action, it is asserted that Claims 1-9 are unpatentable under 35 U.S.C. § 101 as being directed to non-statutory subject matter. With respect to both Independent Claims 1 and 8, as well as dependent Claims 2-3 and 5-7 (all of which depend from Claim 1), the Office Action concludes that “the elements of the claimed invention are directed towards ‘software per se’ and as such are non-statutory.” The Office Action’s characterization of the claimed inventions as directed to “software per se” is incorrect and unsupported by the claims themselves.

With respect to Claims 1-9, the Office maintains its previous position that the inclusion of a software element in an otherwise statutory apparatus claim takes that claim outside of the realm of statutory subject matter. The Office Action’s position is contrary to the Manual of Patent Examination Practice. To be sure, the MPEP expressly states as follows:

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.¹

Even assuming, *arguendo*, that an element in Claim 1 (or any of the other claims) is part of a computer program, that does not end the inquiry. Under MPEP Section 2106.01 I,

¹ See MPEP Section 2106.01 I.

the Office must determine whether “the computer program is being claimed as part of an otherwise statutory manufacture or machine.” That is precisely the case in the present application.

Pending application Claims 1-3 and 5-8 are plainly directed to an apparatus and are written in means-plus-function format pursuant to 35 U.S.C. §112, paragraph 6. The Office Action does not provide any explanation or analysis supporting its assertion as to *why* these apparatus claims as a whole are for “software per se.” Instead, the Office Action simply asserts that “features” recited in the claims “such as ‘registering means’ and ‘license granting means’ are described in the specification (at page 21) as ‘executable client applications.’” Even if these elements are shown, in a preferred embodiment, as executable client applications, that does not support the Office’s assertion that the claims as a whole are non-statutory “software per se.” On the contrary, it is evident from the plain language of each of Claims 1-3 and 5-8 themselves that none of those claims, as a whole, is directed to “software per se.”

For example, Claim 1 recites:

A content delivery system for delivering content to a client of a user who possesses first and second clients, each of said first and second clients using content based on an acquired license, said content delivery system comprising:

registering means for registering each of said first and second clients of said user in order to acquire customer-related information;

customer-related information managing means for managing said customer-related information;

content requesting means for requesting, by said client to a first content provider, acquired content;

content receiving means for receiving, at said first client, acquired content from said first content provider in response to said first content request;

first license requesting means for requesting, by said first client, a first license for the acquired content;

first license granting means which, in response to said request for said first license, issues said first client a first license for the acquired content;

transfer means for transferring the acquired content from said first client to said second client in response to a request to transfer;

second license requesting means for requesting, by the second client to the first license granting means, a second license for the acquired content after said transfer of acquired content to said second client; and

second license granting means which, in response to said second license request, acquires a second license to said transferred acquired content from said first license granting means and issues said second client a second license for the transferred acquired content.

* * * * *

The Office Action fails to explain *why* Claim 1, as a whole, is not statutory. As indicated above, Claim 1 is for “a content delivery system for delivering content to a client of

a user who possesses first and second clients.” By way of example and not by limitation, the Specification (at paragraph [0055]) states that the “clients” may be “reproduction apparatuses” (emphasis added). The Specification also discloses, by way of non-limiting examples, apparatuses that are included in the claimed content delivery system, including: a service database server; a content server; and a license server. These apparatuses are disclosed, for example, in Figure 1 and the related discussion. The Office Action’s assertion that Claims 1-8 are directed to “software per se” is contrary to the language of the claims themselves.

In addition, with respect to method Claim 9, the Office Action asserts that this claim fails “prong 1” because “the tie (e.g., downloading content) is representative of extra-solution activity.” Office Action at p. 3. This assertion is contrary to the plain language of Claim 9, which makes clear that the claimed method is tied to an apparatus. As stated in its preamble, Claim 9 is for “An information processing method for delivering content to a client of a user who possesses at least two clients, each of said clients using content based on an acquired license.” The method of Claim 9 is carried out by steps that are tied to apparatuses. Those steps are performed by machines. Those machines are shown, for example, in Figure 1 of the Specification. *See In re Bilski*, 545 F.3d 943, 954 (“A claimed process is surely patentable under § 101 if: (1) it is tied to a particular machine or apparatus”).

In characterizing Claim 9 as being limited to “downloading content,” the Office Action erroneously ignores the language of Claim 9 as a whole. The Office must consider all of the limitations recited in Claim 9 as defining the metes and bounds of Claim 9. It is error to ignore the claim limitations and to characterize the invention of Claim 9 as being for a method for “downloading content.” *See Bilski*, 545 F.3d at 958 (“the Court has made clear that it is inappropriate to determine the patent-eligibility of a claim as a whole based on

whether selected limitations constitute patent-eligible subject matter.”). The elements in Claim 9 plainly “tie” the claimed method steps to a particular machine or apparatus.

In their response to the May 4, 2009 Office Action, Applicants requested that the Office provide substantial evidence as to how Claims 1-9 can be considered claims to computer “software per se” and how the means-plus-function elements, as recited in Claims 1-8, are interpreted as mandated by M.P.E.P. § 2182-82. Unfortunately, the November 16, 2009 Office Action fails to respond to Applicant’s question. In any event, the previous rejection under Section 101 was contrary to law. Likewise, the present rejection under Section 101 is contrary to law. Accordingly, Applicants respectfully request that the rejection of pending application Claims 1-3 and 5-9 under 35 U.S.C. § 101 be withdrawn.

B. The § 112 Rejection

Pending application Claims 1-3 and 5-7 stand rejected under 35 U.S.C. § 112, second paragraph. The sole grounds for this rejection is the assertion that, in Claim 1, “it is unclear how the ‘second license granting means’ is further modified by a structure”. Although Applicants believe that Claim 1, as originally presented, was not indefinite, as noted above, Claim 1 has been amended herewith. Applicants believe that the amendment to Claim 1 moots any objection regarding the alleged indefiniteness of Claim 1. Therefore, Applicants respectfully request that the rejection of Claims 1-7 under 35 U.S.C. § 112, second paragraph, be withdrawn.

C. The § 103 Rejection

Pending application Claims 1-3, 5-9 and 11 stand rejected under 35 U.S.C. § 103 as obvious over Stefik in view of Cooper and further in view of Horstmann. Applicants respectfully traverse this rejection. As indicated above, the independent claims have been amended herewith. Accordingly, the presently asserted rejection of the pending independent claims is moot.

Applicants assert that none of the applied references, either individually or in combination, discloses all of the elements of independent Claims 1, 8, 9 or 11 as amended. By way of example only, none of the applied references teaches or suggests, either individually or in combination, the following elements in Claim 1: (1) transfer means for transferring the acquired content from said first client to said second client in response to a request to transfer; (2) second license requesting means for requesting, by the second client to the first license granting means, a second license for the acquired content after said transfer of acquired content to said second client; or (3) second license granting means which, in response to said second license request, acquires a second license to said transferred acquired content from said first license granting means and issues said second client a second license for the transferred acquired content.

Claims 2-3 and 5-7 all depend from independent Claim 1. For the reasons discussed above, Claim 1 is not rendered unpatentable based upon Stefik. Furthermore, nothing described or disclosed in either Cooper or Horstmann overcomes the deficiencies in Stefik. Accordingly, Claims 2-3 and 5-7 patentably define over the recited references.

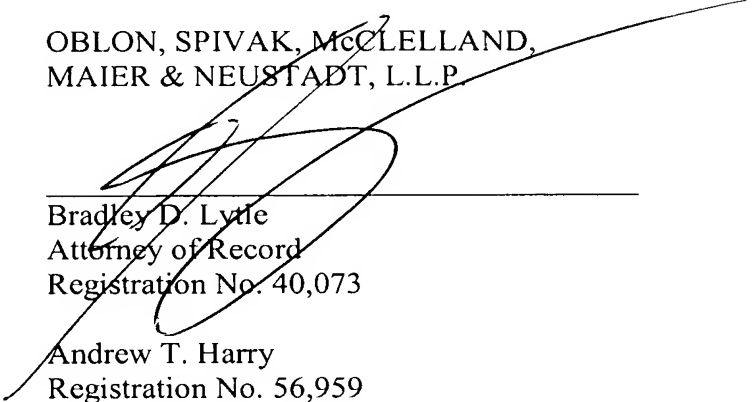
Finally, in the Office Action, Claims 8, 9 and 11 were rejected for precisely the same reasons as Claim 1. For the reasons discussed above, Claims 8, 9 and 11 patentably define over the recited references. Accordingly, Claims 8, 9 and 11 also should be allowed.

In sum, Claims 1-3, 5-9 and 11 of the present application recite statutory subject matter, are definite, and patentably define over the recited references. Accordingly, it is respectfully submitted that the present application is in condition for allowance, and a favorable decision to that effect is respectfully requested.

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Respectfully submitted,

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